

REMARKS

Claims 1 to 15 are currently pending.

Reconsideration of the present application is respectfully requested based on the following remarks.

With respect to paragraph 3 of the Final Office Action, claims 1, 4, 5, and 8 to 14 were rejected under 35 U.S.C. § 103(a) as unpatentable over U.S. Patent No. 6,226,747 to Larsson et al. (hereinafter the “Larsson” reference) in view of U.S. Patent No. 5,109,413 to Comerford et al. (hereinafter the “Comerford” reference).

In rejecting a claim for obviousness under 35 U.S.C. § 103(a), the office bears the initial burden of presenting a prima facie case of obviousness. In re Rijckaert, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993). To establish prima facie obviousness, three criteria must be satisfied. First, there must be some suggestion or motivation to modify or combine the reference teachings. In re Fine, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). Second, there must be a reasonable expectation of success. In re Merck & Co., Inc., 800 F.2d 1091, 231 U.S.P.Q. 375 (Fed. Cir. 1986). Third, the prior art reference(s) must teach or suggest all of the claim features. In re Royka, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974).

Independent claim 1 is directed to a “*device for preventing pirated copies of computer programs for use with a computer.*” As presented, claim 1 includes the features of “*a first memory element containing a data file that is transferable to the computer via the output device, the data file including a key uniquely identifying a licensed copy of the computer program.*” As presented, claim 1 also includes the features in which “*the device is configured to erase the key from the first memory element upon a successful transfer of the data file so that a subsequent attempt to transfer the data file to another computer does not result in a transfer of the key to the other computer unless the key has been transferred back to the device from the computer which received the key.*”

Moreover, independent claims 5, 8 and 13 contain features like those of claim 1.

The “Larsson” reference does not disclose or even suggest the feature in which “*the device is configured to erase the key from the first memory element upon a successful transfer of the data file so that a subsequent attempt to transfer the data file to another computer does not result in a transfer of the key to the other computer unless the key has been transferred back to the device from the computer which received the key.*” Indeed, the Final Office Action acknowledges such by stating “*Larsson does not explicitly disclose wherein the device*

is configured to erase the key from the first memory element upon a successful transfer of the data file so that a subsequent attempt to transfer the data file to another computer does not result in a transfer of the key to the other computer unless the key has been transferred back to the device from the computer which received the key.”

Furthermore, the “Comerford” reference does not cure the critical deficiencies of the “Larsson” reference because there is no valid motivation to combine the “Larsson” reference with the “Comerford” reference in a manner which would make the presently claimed invention obvious. As stated in MPEP section 2143.01.VI, “[t]he proposed modification cannot change the principle of operation of a reference. If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims prima facie obvious. In re Ratti, 270 F.2d 810, 123 USPQ 349 (CCPA 1959)” (some emphasis added). Also, as stated in MPEP section 2143.01.V, “[t]he proposed modification cannot render the prior art unsatisfactory for its intended purpose. If proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. In re Gordon, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984)” (some emphasis added).

The “Comerford” reference merely states the following: “[a] utility program, unning on the host computer, signals the (source) coprocessor that an RDS sequence is about to begin. The utility program identifies to the coprocessor the location of the key to be transferred. . . . The next step in transfer is thus the preparation of an encrypted application key file for storage on the transfer disk. . . . After this preparation and transfer, the utility program, running in the host, then transfers to the transfer set disk the two files containing the plain text and cipher text parts of the protected program. . . . At this point, the right to execute has been deleted from the source coprocessor and exists solely in the Transfer Set” (col. 5, line 10, to col. 6, line 5).

Thus, the “Comerford” reference states, generally speaking, that a key is transferred from a coprocessor to a transfer disk, and the key is then deleted from the coprocessor. The “Comerford” reference refers to this process as “transfer of right-to-execute.”

However, there is no valid motivation to modify the “Larsson” reference using this “transfer of right-to-execute” discussed in the “Comerford” reference.

The “Larsson” reference merely states the following: “a removable read/write storage memory, such as a floppy disk, is linked to the CD. Linking the floppy disk to the CD

is accomplished by storing data on the floppy disk corresponding to data on the CD. Upon initiation of the installation of the computer software program from the CD to the computer, the user is requested to insert a floppy disk into the computer. The present invention then determines whether installation of the computer software from the CD to the computer is authorized by comparing identification information of the computer to identification information previously stored on the floppy disk" (col. 3, lines 47 to 57).

Thus, the "Larsson" system, during the installation of a software program from a CD to a computer, compares identification information on the CD with information on a floppy disk. Furthermore, the "Larsson" reference also states that: "*[i]f the identification information of the computer has not been previously stored on the floppy disk, and if the computer software program has not been installed in excess of the limits of the license, the installation of the computer software from the CD to the computer is allowed. If, on the other hand, the linked floppy disk is not present or the user has previously installed the computer software on a number of computers equaling the terms of the license agreement, installation is disallowed" (col. 3, lines 57 to 65). Thus, the "Larsson" system uses the information on the floppy disk for the installation of the software program on multiple computers, up to the limit allowed by the license agreement.*

However, if the system (and/or method) of the "Larsson" reference were modified using 'transfer of right-to-execute' of the "Comerford" reference (the appropriateness of which is not conceded), the resulting modified system would change the principle of operation of the system of the "Larsson" reference and also render the system of the "Larsson" reference inoperable, and therefore unsatisfactory for its intended purpose.

That is, the "transfer of right-to-execute" of the "Comerford" reference, if applied to the system of the "Larsson" reference, would transfer the information contained on the floppy disk of the "Larsson" reference to a different location. However, the "Larsson" system is completely predicated upon comparing the identification information on the CD with the information on the floppy disk. (For example, the information on the floppy disk is used a plurality of different times during the installation of the software program on a plurality of different computers.) Thus, if this information is no longer on the floppy disk, the principle of operation of the "Larsson" system is completely changed. Therefore, according to MPEP Section 2143.01.VI, since the principle of operation of a reference is altered, the "Larsson" and "Comerford" references do not render the claims prima facie obvious.

Furthermore, because the “Larsson” system is completely predicated upon comparing the identification information on the CD with the information on the floppy disk, if this information is no longer on the floppy disk, the “Larsson” system will not even function. For example, if the information is no longer on the floppy disk, the “Larsson” system could not be used to install the software program on multiple computers, because the floppy disk will not be able to perform its function (for example during a hypothetical later installation) if the information has been removed (for example during a hypothetical earlier installation on a specific computer). Moreover, since installation on multiple computers is a prominent aspect of the “Larsson” system, without this aspect the “Larsson” reference is rendered unsatisfactory for its intended purpose without this aspect. Therefore, according to MPEP Section 2143.01.V, since the proposed modification would make the reference unsatisfactory for its intended purpose, there is no suggestion or motivation to make the proposed modification of the “Larsson” reference using the “Comerford” reference.

Thus, because a modification of the “Larsson” system by using the “transfer of right-to-execute” of the “Comerford” reference would change the principle of operation of the “Larsson” reference, and would render the “Larsson” reference unsatisfactory for its intended purpose, there is no valid motivation to combine the “Larsson” and “Comerford” references as asserted.

As further regards all of the obviousness rejections of the claims (including those discussed below), it is respectfully submitted that not even a *prima facie* case has been made in the present case for obviousness, since the Office Actions to date never made any findings, such as, for example, regarding in any way whatsoever what a person having ordinary skill in the art would have been at the time the claimed subject matter of the present application was made. (See *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1455 (Fed. Cir. 1998) (the “factual predicates underlying” a *prima facie* “obviousness determination include the scope and content of the prior art, the differences between the prior art and the claimed invention, and the level of ordinary skill in the art”)). It is respectfully submitted that the proper test for showing obviousness is what the “combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art”, and that the Patent Office must provide particular findings in this regard — the evidence for which does not include “broad conclusory statements standing alone”. (See *In re Kotzab*, 55 U.S.P.Q. 2d 1313, 1317 (Fed. Cir. 2000) (citing *In re Dembiczak*, 50 U.S.P.Q.2d 1614, 1618 (Fed. Cir. 1999) (obviousness rejections reversed

where no findings were made “concerning the identification of the relevant art”, the “level of ordinary skill in the art” or “the nature of the problem to be solved”))). It is respectfully submitted that there has been no such showings by the Office Actions to date or by the Advisory Action.

In fact, the present lack of any of the required factual findings forces both Appellants and any Appeals Board to resort to unwarranted speculation to ascertain exactly what facts underlie the present obviousness rejections. The law mandates that the allocation of the proof burdens requires that the Patent Office provide the factual basis for rejecting a patent application under 35 U.S.C. § 103. (See *In re Piasecki*, 745 F.2d 1468, 1472, 223 U.S.P.Q. 785, 788 (Fed. Cir. 1984) (citing *In re Warner*, 379 F.2d 1011, 1016, 154 U.S.P.Q. 173, 177 (C.C.P.A. 1967))).

In short, the Office bears the initial burden of presenting a proper prima facie unpatentability case — which has not been met in the present case. (See *In re Oetiker*, 977 F.2d 1443, 1445, 24, U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992)).

Therefore, independent claims 1, 5, 8 and 13, and their dependent claims, are allowable over the “Larsson” reference in view of the “Comerford” reference, and it is respectfully requested that the obviousness rejections be withdrawn.

With respect to paragraph 13 of the Final Office Action, claims 2 and 3 were rejected under 35 U.S.C. §103(a) as obvious over the “Larsson” reference in view of the “Comerford” reference, and further in view of U.S. Patent No. 6,523,119 to Pavlin et al. (hereinafter the “Pavlin” reference).

Claims 2 and 3 depend from independent claim 1, and are therefore allowable over the “Larsson” reference in view of the “Comerford” reference for the reasons explained above, since the third-level “Pavlin” reference does not cure the critical deficiencies of the primary and secondary references as explained above. Therefore, claims 2 and 3 are allowable.

With respect to paragraph 16 of the Final Office Action, claim 6 was rejected under 35 U.S.C. §103(a) as obvious over the “Larsson” reference in view of the “Comerford” reference, further in view of U.S. Patent No. 6,434,535 to Kupka (hereinafter the “Kupka” reference), and further in view of U.S. Patent No. 6,411,941 to Mullor et al. (hereinafter the “Mullor” reference).

Claim 6 depends from independent claim 5, and is therefore allowable over the “Larsson” reference in view of the “Comerford” reference for the reasons explained above,

since the third-level “Pavlin” reference and the fourth-level “Mullor” reference do not cure the critical deficiencies of the primary and secondary references as explained above.

Therefore, claim 6 is allowable.

With respect to paragraph 18 of the Final Office Action, claim 7 was rejected under 35 U.S.C. §103(a) as obvious over the “Larsson” reference in view of the “Comerford” reference.

Claim 7 depends from independent claim 5, and is therefore allowable over the “Larsson” reference in view of the “Comerford” reference for the reasons explained above.

With respect to paragraph 20 of the Final Office Action, claim 15 was rejected under 35 U.S.C. §103(a) as obvious over the “Larsson” reference in view of the “Comerford” reference, further in view of the “Kupka” reference and the “Mullor” reference.

Claim 15 depends from independent claim 13, and is therefore allowable over the “Larsson” reference in view of the “Comerford” reference for the reasons explained above, since neither the third-level “Pavlin” reference nor the fourth-level “Mullor” reference cure the critical deficiencies of the primary and secondary references as explained above.

Therefore, claim 15 is allowable.

Accordingly, claims 1 to 15 are allowable.

U.S. Patent Application No. 09/750,423
Attorney Docket No. 10191/1665
Reply to Final Office Action of June 20, 2007

CONCLUSION

In view of the foregoing, it is respectfully submitted that all of the presently pending claims are allowable. It is therefore respectfully requested that the rejections be withdrawn since they have been obviated. All issues raised by the Examiner having been addressed, an early and favorable action on the merits is respectfully requested.

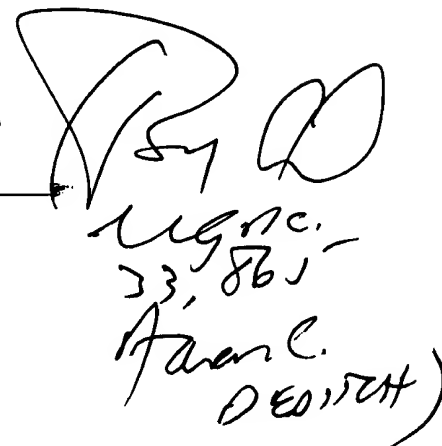
Respectfully submitted,
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Dated: 10/18/2007

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